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26171 7590 02/13/2008 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER VU, THANH T	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/747,652	Applicant(s) BLATTNER ET AL.	
	Examiner THANH T. VU	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/06/08; 12/14/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/06/2007 has been entered.

This communication is responsive to Amendment, filed 12/06/2007.

Claims 1-86 are pending in this application. In the Amendment, Claims 69-70 were canceled, claims 85-86 were added, and claims 1, 54, 63, 65-68 and 72 were amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7-8, 18-32, 35-43, 47-55, 57-58, 60-64, 66-67, and 69-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles et al. ("Liles" U.S. Pat. No. 5,880,731) and Kim (U.S. Pat. No. 6,910,186).

Per claim 1, Liles teaches a method for communicating, the method comprising:
graphically representing, with an avatar capable of being animated, a first user in a communication session involving the first user and a second user (col. 3, lines 52-67);
communicating a message between the first user and the second user, the message conveying explicit information from the first user to the second user (col. 3, lines 32-41); and
communicating out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, wherein the out-of-band communication differs from the information conveyed in the message sent between the first user and the second user (col. 3, lines 28-42; col. 9, lines 55-65; *a participant can select and animate the avatar related to a context of the participant along with text message sent between participants*).

Liles does not specifically teach receiving, independently of the first user and the message, out-of-band information indicating a context of the first user and communicating, based on stored data association, the out-of-band information to the second user by changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information. However, Kim teaches receiving, independently of the first user and the message, out-of-band information indicating a context of the first user and communicating, based on stored data association, the out-of-band information to the second user by changing an animation of the avatar representing the first user to

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graphically convey the context of the first user indicated by the received out-of-band information (fig. 4B step 123; fig. 4D, step 137; col. 5, lines 41-50; col. 15, lines 10-17, lines 55-67; *which shows different behavior options for an avatar representing a user and behavior options of the avatar (i.e. animated avatar) are received by other users in the virtual environment*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of Liles in order to provides a mechanism that enable user who uses an avatar to represent himself in a chat room may make his avatar not only express various emotions, but also make it physically interact with another avatar (Kim, col. 5, lines 46-50).

Per claim 2, the modified Liles teaches the method of claim 1 wherein the communication session is an instant messaging communication session (Liles, col. 3, lines 58-62; *online chat session*).

Per claim 3, the modified Liles the method of claim 1 wherein the avatar comprises a facial animation that does not include a body having an ear or a leg (Liles, fig. 7; element 124; col. 7, lines 49-54; *a user can modify an animation to include or exclude various features*).

Per claim 4, the modified Liles teaches the method of claim 1 wherein the avatar comprises a facial animation, including a neck, that does not include a body having an ear or a leg (Liles, fig. 7; animation 122; col. 7, lines 49-54; *a user can modify an animation to include or exclude various features*).

Per claim 7, the modified Liles teaches the method of claim 1 wherein the out-of-band information comprises information indicating a personality characteristic associated with the first user (Liles, col. 6, lines 50-67; *character setting*).

Per claim 8, the modified Liles teaches the method of claim 1 wherein the out-of-band information comprises information indicating an emotional state associated with the first user (Liles, col. 3, lines 32-34).

Per claim 18, the modified Liles teaches the method of claim 1 wherein out-of-band information comprises information related to a mood of the first user (Liles, fig. 7; col. 2, lines 32-34).

Per claim 19, the modified Liles teaches the method of claim 18 wherein the mood of the first user comprises one of happy, sad or angry (Liles, fig. 7; col. 2, lines 32-34).

Per claim 20, the modified Liles teaches the method of claim 1 wherein out-of-band information comprises information associated with an activity of the first user (Liles, col. 7, lines 18-42).

Per claim 21, the modified Liles teaches the method of claim 20 wherein the activity is being performed by the first user at the same time that the out-of-band message is communicated from the first user to the second user (Liles, col. 7, lines 18-42; *a user can perform an activity (i.e checking a watch) at the same time a message is sent to another user*).

Per claim 22, the modified Liles teaches the method of claim 21 wherein the activity comprises one of working or listening to music (Liles, col. 7, lines 50-55; *a user works on customizing the avatar*).

Per claim 23, the modified Liles teaches the method of claim 5 wherein out-of-band information comprises information conveying that the first user has muted sounds associated with the avatar (Liles, col. 9, lines 1-5; *user can modified the avatar completely as desired*).

Per claim 24, the modified Liles teaches the method of claim 1 further comprising triggering, based on the information conveyed in the message from the first user to the second user, an animation of the avatar to convey the out-of-band information from the first user to the second user (Liles, col. 7, lines 18-22; col. 9, lines 55-65 and col. 10, lines 28-32; *a user can select an animation to convey a message to send to another user*).

Per claim 25, the modified Liles teaches the method of claim 24 wherein the trigger comprises a portion of text (Liles, col. 9, lines 55-65).

Per claim 26, the modified Liles teaches the method of claim 24 wherein the trigger comprises all of the text of the message (Liles, col. 9, lines 55-65 and col. 10, lines 28-32; *a user can select an animation in response to messages sent between the users*).

Per claim 27, the modified Liles teaches the method of claim 24 wherein the trigger comprises an audio portion of the message (Liles, col. 9, lines 55-65 and col. 10, lines 28-32; col. 13, lines 35-41; *a user can select an animation in response to the sound when a user joins the chat session*).

Per claim 28, the modified Liles teaches the method of claim 24 wherein the trigger comprises passing a predetermined amount of time during which the first user does not communicate a message to the second user (Liles, col. 9, lines 24-26).

Per claim 29, the modified Liles teaches the method of claim 24 wherein the trigger comprises passing a predetermined amount of time during which the first user does not use a computing device that is used by the first user to communicate with the second user in the communication session (Liles, col. 9, lines 24-26).

Per claim 30, the modified Liles teaches the method of claim 1 wherein the avatar animation that graphically conveys the context of the first user comprises a facial expression of the avatar (Liles, fig. 7).

Per claim 31, the modified Liles teaches the method of claim 1 wherein the avatar animation that graphically conveys the context of the first user comprises a gesture made by a hand of the avatar or a gesture made by an arm of the avatar (Liles, col. 7, lines 30-35).

Per claim 32, the modified Liles teaches the method of claim 1 wherein the avatar animation that graphically conveys the context of the first user comprises movement of a body of the avatar (Liles, col. 7, lines 30-35).

Per claim 35, the modified Liles teaches the method of claim 1 wherein the avatar animation that graphically conveys the context of the first user comprises a breakout animation that involves displaying avatar outside of normal display space occupied by the avatar (Liles, col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired and move avatar within the room*).

Per claim 36, the modified Liles teaches the method of claim 35 wherein the breakout animation comprises telescoping the avatar (Liles, col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired*).

Per claim 37, the modified Liles teaches the method of claim 35 wherein the breakout animation comprises resizing the avatar (Lilies, col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired*).

Per claim 38, the modified Liles teaches the method of claim 35 wherein the breakout animation comprises repositioning the avatar (Liles, col. 7, lines 13-16 and col. 9, lines 1-5; *a user can modify the avatar as desired and move avatar within the room*).

Per claim 39, the modified Liles teaches the method of claim 1 further comprising providing the first user with multiple preconfigured avatars having associated preselected animations and enabling the first user to select a particular avatar to represent the user in the communications session (Liles, col. 9, lines 34-46).

Per claim 40, the modified Liles teaches the method of claim 39 further comprising persistently associating the first user with the selected avatar to represent the first user in subsequent communication sessions (Liles, col. 9, lines 34-46; *a user can select an avatar to represent the user*).

Per claim 41, the modified Liles teaches the method of claim 39 further comprising enabling the first user to modify the appearance of the avatar (Liles, col. 9, lines 1-5).

Per claim 42, the modified Liles teaches the method of claim 41 wherein enabling the first user to modify the appearance of the avatar comprises enabling the first user to use a slide bar to indicate a particular modification of a particular feature of the avatar (Liles, fig. 3; *a user can use the scroll bar to select a different avatar to change the appearance of the avatar in the chat room*).

Per claim 43, the modified Liles teaches the method of claim 41 wherein enabling the first user to modify the appearance of the avatar comprises enabling the first user to modify appearance of the avatar to reflect a characteristic of the first user (Liles, fig. 3; col. 9, lines 1-5;

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a user can select an avatar to reflect a characteristic of the user or modify the avatar as desired).

Per claim 47, the modified Liles teaches the method of claim 1 further comprising enabling the first user to modify a trigger used to cause an animation of the avatar (Liles, col. 8, line 61-col. 9, line 5).

Per claim 48, the modified Liles the method of claim 47 wherein the trigger comprises text included in the message sent from the first user to the second user (Liles, col. 7, lines 18-22; col. 9, lines 55-65; *a user can select animation in response to message sent between the users*).

Per claim 49, the modified Liles teaches the method of claim 1 further comprising animating the avatar for use as an information assistant to convey information to the first user (Liles, col. 7, lines 25-35).

Per claim 50, the modified Liles teaches the method of claim 1 further comprising enabling use of the avatar by an application other than a communications application (Liles, col. 9, lines 4-15; *a bitmap file can be view by other application that is able to view bitmap files*).

Per claim 51, the modified Liles teaches the method of claim 50 wherein enabling use of the avatar by an application other than a communications application comprises enabling use of the avatar in an online journal (Liles, col. 9, lines 4-15; *a bitmap file can be view by other application that is able to view bitmap files*).

Per claim 52, the modified Liles teaches the method of claim 1 further comprising displaying a depiction of the avatar in the form that is similar to a trading card (Liles, col. 9, lines 9-15; *a user can send their customized avatar to other users*).

Per claim 53, the modified Liles teaches the method of claim 52 wherein the trading card depiction of the avatar comprises a trading card depiction of the avatar that includes characteristics associated with the first user (Liles, col. 1-5; a user can customized the avatars as desired).

Claims 54 and 55 are rejected under the same rationale as claims 1 and 2 respectively.

Claims 57 and 58 are rejected under the same rationale as claims 7 and 8 respectively.

Claims 60, 61, and 62 are rejected under the same rationale as claims 18, 20, 47 respectively.

Claims 63 and 64 are rejected under the same rationale as claims 1 and 2 respectively.

Claims 66 and 67 are rejected under the same rationale as claims 7 and 8 respectively.

Claim 71 are rejected under the same rationale as claims 47 .

Claim 72 is rejected under the same rationale as claim 1.

Per claim 73, the modified Liles teaches the system of claim 72, wherein the means for graphically representing comprises means for graphically representing an avatar and an associated background display (Liles, fig. 13; *avatar 254 and associated background*).

Per claim 74, the modified Liles teaches the system of claim 72, wherein the out-of-band information comprises information associated with an activity of the first user determined based on user interaction with a computer application occurring during a time when the message is communicated between the first user and the second user (Tang, col. 5, lines 1-18; col. 8, lines 55-65).

Per claim 75, the modified Liles teaches the system of claim 72, further comprising:
means for determining whether to change the avatar appearance or avatar animation to
communicate the received out-of-band information based on other out-of-band information
received independently of the first user and the message (Tang, col. 7, lines 55-65; col. 13, lines
57-64; col. 15, lines 5-15; col. 18, lines 55-67; *shows changing appearance of a user*).

Claims 76-78 are rejected under the same rationale as claims 73-75 respectively.

Claims 79-81 are rejected under the same rationale as claims 73-75 respectively.

Claims 82-84 are rejected under the same rationale as claims 73-75 respectively.

Claim 85 is rejected under the same rationale as claim 20.

Claim 86 is rejected under the same rationale as claim 52.

Claims 5-6, 9-17, 56, 59, 65, and 68 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Liles, Kim (U.S. Pat. No. 6,910,186) and Kim et al. (WO 01/84461 A1).

Per claim 5, the modified Liles teaches the method of claim 1, but does not teaches
wherein the out-of-band information comprises information indicating an environmental
condition associated with the first user. However, Kim et al teaches the out-of-band information
comprises information indicating an environmental condition associated with the first user (page
2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the
time of the invention to include the teaching of Kim et al. in the invention of the modified Liles
because it provides users with an enjoyable on-line chatting using various setting for a character
in the virtual world that reflect the real world setting of a user.

Per claim 6, the modified Liles teaches the method of claim 5 wherein the environmental condition comprises an environmental condition related to weather occurring in a geographic location near the first user (Liles, col. 2, lines 10-14 and lines 28-30).

Per claim 9, the modified Liles teaches the method of claim 1, but does not specifically teach wherein the out-of-band information comprises information indicating a setting characteristic associated with the first user. However, Kim teaches the out-of-band information comprises information indicating a setting characteristic associated with the first user (page 2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of the modified Liles because it provides users with an enjoyable on-line chatting using various setting for a character in the virtual world that reflect the real world setting of a user.

Per claim 10, the modified Liles teaches the method of claim 9 wherein the setting characteristic comprises a characteristic related to time of day of the first user (Kim, col. 2, line 23).

Per claim 11, the modified Liles the modified Liles teaches the method of claim 9 wherein the setting characteristic comprises a characteristic related to time of year (Kim, col. 2, lines 5-9).

Per claim 12, the modified Liles teaches the method of claim 11 wherein the time of year comprises a holiday (Kim, col. 2, lines 5-9; *each season comprises a holiday*).

Per claim 13, the modified Liles teaches the method of claim 11 wherein the time of year comprises a season wherein the season is one of spring, summer, fall or winter (Kim, col. 2, lines 5-9).

Per claim 14, the modified Liles teaches the method of claim 9 wherein the setting characteristic comprises a characteristic associated with a work setting (Kim, col. 2, lines 10-14 and lines 29-34; *geographic setting or physical location of the user*).

Per claims 15-17, the modified Liles teaches the method of claim 9 wherein the setting characteristic comprises a characteristic associated with a recreation setting such as a beach setting, a tropical setting, or a winter sport setting (Kim, col. 2, lines 10-14 and lines 29-34; *it is noted the geographic setting where the user lives or physical location of the user may comprises a recreation setting*).

Claim 56 is rejected under the same rationale as claim 5.

Claim 59 is rejected under the same rationale as claim 9.

Claim 65 is rejected under the same rationale as claim 5.

Claim 68 is rejected under the same rationale as claim 9.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles, Kim (U.S. Pat. No. 6,910,186) and Matsuda (U.S. Pat. No. 7,007,065).

Per claims 33 and 34, the modified Liles teaches the method of claim 1, but does not teach wherein the avatar animation that graphically conveys the context of the first user comprises sounds made by the avatar, and wherein at least some of the sounds comprise a voice based on a voice of the first user. However Matsuda teaches wherein the avatar animation that graphically conveys the context of the first user comprises sounds made by the avatar, and wherein at least some of the sounds comprise a voice based on a voice of the first user (col. 1, lines 8-10; col. 3, lines 30-34; col. 5, lines 50-55). Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to include the teaching of Matsuda in the invention of the modified Liles in order to provide an avatar that is active in a shared virtual space, and made to output a sound during a chat.

Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles, Kim and Ostermann et al. (“Ostermann”, U.S. Pat. No. 7,177,811).

Per claims 44-46, the modified Liles teaches modification of the appearance and characteristic of a user as described above, but does not specifically teach wherein the characteristic of the first user comprises one of age, gender, hair color, eye color, or a facial feature, the appearance of the avatar comprises enabling the first user to modify appearance of the avatar by adding, changing or deleting a prop displayed with the avatar, and wherein the prop comprises one of eyeglasses, sunglasses, a hat, or earrings. However, Ostermann teaches wherein the characteristic of the first user comprises one of age, gender, hair color, eye color, or a facial feature, the appearance of the avatar comprises enabling the first user to modify appearance of the avatar by adding, changing or deleting a prop displayed with the avatar, and wherein the prop comprises one of eyeglasses, sunglasses, a hat, or earrings (fig. 9; col. 11, line 60-col. 12, line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Ostermann in the invention of the modified Liles in order to provide further customizations to the user’s avatar in a chat session.

Response to Arguments

Applicant's arguments with respect the amendment have been considered but are moot in view of the new ground(s) of rejection.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/
Examiner, Art Unit 2174